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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,462	03/11/2004	Brian R. Samuels	29214/40015	6413
4743	7590	03/08/2006	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			PATTERSON, MARC A	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/798,462	Applicant(s) SAMUELS, BRIAN R.	
	Examiner Marc A. Patterson	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
 4a) Of the above claim(s) 18-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/23/04, 9/17/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 – 17, drawn to a film, classified in class 428, subclass 35.7.
 - II. Claims 18 – 41, drawn to a method of preparing a film, classified in class 264, subclass 177.2.
2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a materially different method, such as solution casing of the film followed by surface activation treatment.
3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. James Napoli on February 27, 2006, a provisional election was made with traverse to prosecute the invention of I, claims 1 - 17. Affirmation of this election must be made by applicant in replying to this Office action. Claims

18 – 41 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to Claim 1, the term ‘dynes’ is indefinite as its meaning is unclear. For purposes of examination, the term will be interpreted to mean ‘dynes/cm.’

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 – 5, 7 – 15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Beckwith et al (WO 97/36798).

With regard to Claims 1 – 3, Beckwith et al disclose a film having a liquid absorbed therein (a solution of a modifier, therefore a liquid, is sorbed into a film; page 15, lines 2 – 12), the surface of the film having a surface energy of at least 50 dynes; the liquid is applied to the surface of the film (the film is immersed in a bath of modifier; page 14, lines 22 – 25) and prior

to the application of the liquid the surface has been subjected to a surface activation treatment (corona treatment, therefore corona discharge; page 13, lines 16 – 21). However, the claimed aspects of the film being treated by corona discharge prior to the application, and of the liquid application, are given little patentable weight as the limitations are directed to process limitations.

With regard to Claims 4 – 5, the claimed aspects of the film being treated by corona discharge at between 100 and 600 W-m/M² and of the liquid application, are given little patentable weight as the limitations are directed to process limitations.

With regard to Claim 7, the film disclosed by Beckwith et al is a food packaging film having a food contact surface (food contact layer used for cook – in; page 9, lines 1 – 7).

With regard to Claims 8 and 10, the liquid disclosed by Beckwith et al is absorbed into a layer comprising polyamide (ether / amide copolymer; page 10, lines 27 – 30), therefore a monolayer of polyamide.

With regard to Claim 9, the film disclosed by Beckwith et al also comprises a polyvinylpyrrolidone (page 12, line 11) and is crosslinked (page 11, line 17).

With regard to Claim 11, the film disclosed by Beckwith et al has two layers (multilayer film; page 7, lines 14 – 20) comprising a polyamide layer which is an inner layer (page 19, lines 7 – 14) and a polyolefin layer which is an outer layer (page 17, lines 7 – 9).

With regard to Claim 12, the film disclosed by Beckwith et al is in the form of a tubular casing (page 22, lines 24 – 26).

With regard to Claim 13, the Beckwith et al discloses a film having a water sorption capacity (page 9, lines 30 – 31); the liquid disclosed by Beckwith et al therefore consists essentially of water.

With regard to Claims 14 – 15 and 17, the liquid disclosed by Beckwith et al comprises a composition comprising an additive for transfer to a food product comprising a flavoring agent (liquid smoke; page 15, line 26) the liquid therefore comprises an anti – viral agent as it induces eating , and therefore destruction of the food product and thus prevents the infection of the food product with viruses.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beckwith et al (WO 97/36798).

Beckwith et al disclose film comprising a liquid which has been applied to a surface as stated above. Beckwith et al fail to disclose a liquid that is applied in amount of between 0.4 to 10 mg/cm². However, Beckwith et al disclose a liquid that is applied in amount which provides sorption of a relatively large amount of modifier (page 15, lines 12 – 15). Therefore, one of ordinary skill in the art would have recognized the utility of varying the amount of the liquid applied to obtain the desired amount of liquid absorbed. Therefore, the amount of liquid

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absorbed would be readily determined by through routine optimization of the amount of the liquid applied by one having ordinary skill in the art depending on the desired use of the end product as taught by Beckwith et al.

It therefore would be obvious for one of ordinary skill in the art to vary the amount of the liquid applied in order to obtain the desired amount of liquid absorbed, since the amount of liquid absorbed would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Beckwith et al.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beckwith et al (WO 97/36798) in view of Luthra et al (European Patent No. 0986957).

Beckwith et al disclose film for a food casing comprising a modifier, therefore an additive, as stated above. Beckwith et al fail to disclose an additive that comprises a Maillard reagent.

Luthra et al teach a film (paragraph 0001) having an additive that comprises a Maillard reagent (sugar; paragraph 0042) for a food casing (packaging for meat products; paragraph 0002) for the purpose of obtaining a food casing that provides transfer of flavor from the film (paragraph 0001). One of ordinary skill in the art would therefore have recognized the advantage of providing for the additive of Luthra et al in Beckwith et al, which comprises film for a food casing, depending on the desired transfer of flavor of the end product.

It therefore would have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for an additive that comprises a Maillard

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reagent in Beckwith et al in order to obtain transfer of flavor from the film as taught by Luthra et al.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc A Patterson whose telephone number is 571-272-1497.

The examiner can normally be reached on Mon - Fri 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marc Patterson 3/6/06
Marc A. Patterson, PhD.
Primary Examiner
Art Unit 1772